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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/371,716	08/09/1999	IGOR SINYAK	884.006US2	9571

21186 7590 06/08/2005

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EXAMINER

BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/371,716

Applicant(s)

SINYAK ET AL.

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/9/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-8, 10, 11 and 27 is/are allowed.
- 6) ☒ Claim(s) 1-5, 12-26 and 28-31 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This action is responsive to communications: decision by the Board of Patent Office Appeals and Interferences (BPOAI), said decision rendered 2/9/2005.
2. Claims 1-31 pending. Claims 1, 6, 11-13, 18, 23-25 are independent.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **The claimed invention (as claimed in claims 12-24, 28-30) is directed to non-statutory subject matter.**

In regard to independent claims 12, 13, 18, 23, 24, each of said claims recite “*encoded in a carrier medium...*”, which renders said claims non-statutory, as not being tangible embodied in a manner so as to be executable and is non-statutory for failing to be in one of the categories of invention. The examiner’s suggestion of amending each of said claim to recite “*encoded in a storage medium...*” will serve to overcome this rejection.

In regard to dependent claims 14-17, 19-22, 28-30, claims 14-17, 19-22, 28-30 are rejected for fully incorporating the deficiencies of their respective base claims.

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Allowable Subject Matter

5. Claims 6-8, 10-11, 27 are allowed.
6. Claims 12, 18-24, 28, 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.
7. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 13, 25-26, 29, 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Thielens et al. (hereinafter Thielens), U.S. Patent No. 5,666,139 issued September 9, 1997.

In regard to independent claim 1, Thielens discloses a method relating to editing and displaying of text onto pages of a screen display (Thielens Abstract, Figures 3-5, 6-11, 14 – note page numbers in said figures.).

Thielens discloses “line formatted” material (Thielens column 20 lines 18-19). It is noted that Thielens disclosure of keeping track of a lower boundary or line delimiter (i.e. “the 40th line”, etc.) implies that Thielens

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keeps numerical track of textual lines (along with content in each line) in a document, therefore the lines are formatted accordingly.

Thielens discloses adjacent columns (Thielens Figures 3-5, 6). It is noted that Thielens shows page numbering (<1>, <2> etc.) at top right of each screen. Since page 2 typically follows page 1 (and since documents are typically read (line by line) from top to bottom), the single textual column bottom of page one is adjacent to the single column top of page two (two adjacent columns).

Thielens discloses text scrolling to a subsequent page (Thielens Figure 5A items 164, 166, 168). Thielens also discloses spilling/scrolling onto the next sub-page during editing (Thielens column 20 lines 15-21).

In regard to independent claim 13, claim 13 reflects the computer program product comprising computer readable instructions used for performing the methods as claimed in claim 1, and is rejected along the same rationale.

In regard to independent claim 25, claim 25 reflects the system comprising computer readable instructions used for performing the methods as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claim 26, Thielens discloses graphical elements (Thielens Figures 3-5).

In regard to dependent claim 29, claim 29 reflects the computer program product comprising computer readable instructions used for performing the methods as claimed in claim 26, and is rejected along the same rationale.

In regard to dependent claim 31, claim 31 reflects the system comprising computer readable instructions used for performing the methods as claimed in claim 26, and is rejected along the same rationale.

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 2-3, 5, 14-15, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thielens.**

In regard to dependent claims 2, 3, Thielens teaches a keyboard (Thielens column 87 lines 18-21).

Thielens does not specifically teach a "single" key, or a mouse, nevertheless, since it has been well established that single keyboard keys (i.e. up/down arrow keys), as well as a mouse can be used for cursor direction/scrolling during a document editing session, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply the above to Thielens's editor, providing the benefit of alternate scrolling methods for various user tastes.

In regard to dependent claim 5, Thielens does not specifically teach diagonally opposing ends of lines of a column, etc. However, since Thielens teaches documents displayed in the English language (Thielens Figure 6), and since it is well established that the English language is read from left to right, it would have been obvious to one of ordinary skill in the art at the time of the invention for Thielens's scrolling behavior to match diagonally opposing ends of both columns, providing the benefit of mimicking the natural flow of the English language when read left to right (and line by line).

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In regard to dependent claims 14-15, 17, claims 14-15, 17 reflect the computer program product comprising computer readable instructions used for performing the methods as claimed in claims 2-3, 5, respectively, and are rejected along the same rationale.

12. Claims 4, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thielens, as applied to claims 1 and 13 above, and further in view of Haran (hereinafter Haran), U.S. Patent No. 6,072,461 issued June 2000.

In regard to dependent claim 4, Thielens does not specifically teach a single microphone voice command. However, Haran teaches document generation whereby scrolling is operative in response to a voice command (typically utilizing a microphone) (Haran column 3 lines 1-3, also column 15 lines 13-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Haran to Thielens, providing Thielens the benefit of voice control as an alternate input (i.e. for the physically handicapped, etc.).

In regard to dependent claim 16, claim 16 reflects the computer program product comprising computer readable instructions used for performing the methods as claimed in claim 4, and is rejected along the same rationale.


Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

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14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


WILLIAM BASHORE
PRIMARY EXAMINER

June 5, 2005


STEPHEN HONG
SUPERVISORY PATENT EXAMINER

*approved for re-opening.
Patterson, Asst. Director
TC2100*